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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/898,853	07/25/1997	HISASHI YAMAGISHI	Q45980	6473

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EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 49

Application Number: 08/898,853
Filing Date: July 25, 1997
Appellant(s): YAMAGISHI ET AL.

Robert M. Masters
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 8, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 13-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 13-19 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office Action, Paper No. 39.

(11) Response to Argument

Appellant argues the claimed subject matter is fully supported by the disclosure. The disclosure supports a golf ball comprising an inner sphere, a surrounding layer and a two-layer cover. The surrounding layer may optionally include an additional layer. This is inconsistent with appellant's claimed subject matter. Appellant claims a golf ball comprising core with three layers and a cover. Appellant's original disclosure states the cover consists of at least two layers (see pg. 2, lines 14-18, pg. 3, lines 24-29, pg. 5, lines 9-10), therefore appellant's claimed cover must be read to include the at least two cover layers, each of which must have differing hardnesses (see specification at page 3, lines 24 thru page 4, line 9). Considering the full disclosure the claimed golf ball consists of a three-layer core and a two-layer cover or a five-piece golf ball. Because the cover must contain at least two layers it is the outermost layer of the surrounding layer that must have the attributes given to the outer core layer in claims 13-19. Although appellant originally disclosed three core layers, none of the properties for this third core layer with the required two-layer cover were given. Since appellant specifically discloses the cover must include two layers and claims a golf ball comprising a three-layer core and a cover the definition of the cover as disclosed must be applied. Claims must be read in view of the specification, of which they are a part.

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The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. See *Markman v. Westview Instruments Inc.* 34 USPQ2d 1321. For this reason the balance of appellants' arguments pertaining to the dependent claims 14-19 and their limitations are also unpersuasive.


Appellant further argues there is no substantial difference between what has been disclosed as an inner cover layer, and, what the patent with which appellants seek to provoke an interference, discloses as an outer core layer. However, this position is at odds with that taken by the appellants in paper 6, filed October 28, 1998 (pg 5, lines 3-7, 18-19; pg 6, lines 19-23) where appellants argued that prior art showing a three piece core and a cover is "*completely distinguishable*", page 5, line 6, from the ball of the applicants' claims, (emphasis added). These remarks were made in an attempt to overcome a prior art rejection. Under file wrapper estoppel doctrine applicants are estopped from now arguing that the inner cover layer may be considered an outer core layer or vice-versa. See *Gentry Gallery Inc. v. The Berkline Corp.* 45 USPQ2d 1498. (Our present analysis of infringement under the doctrine of equivalents involves prosecution history estoppel, also a question of law which we review *de novo*, p.1501. Similarly, the argument advanced in the PTMS precludes recovery under the doctrine of equivalents because of prosecution history estoppel. Arguments made by an applicant in a PTMS can create an estoppel, and thus preclude a finding of infringement under the doctrine of equivalents. p. 1501)

In conclusion it is submitted that appellant cannot within the original disclosure disclose that the invention must have a two-layer cover, each cover layer having specific hardness requirements, then subsequently argue that such a two layer cover cannot be read on a cover and an underlayer meeting those hardness requirements, and then subsequently argue that the original disclosure supports claims to a cover and an underlayer having those same characteristics.



For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Raeann Gorden


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Supervisory Patent Examiner
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rg
January 21, 2003

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